PATENT COOPERATION TREATY

PCT

REC'D 0 7 JUN 2004

WIPO   PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Article 36 and Rule 70)

26 JAN 2005

Applicant's or agent's file reference PAT 53996W-90	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/CA 03/01150	International filing date *(day/month/year)* 29.07.2003	Priority date *(day/month/year)* 29.07.2002

International Patent Classification (IPC) or both national classification and IPC

H04L12/58

Applicant

RESEARCH IN MOTION LIMITED

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

   ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

   These annexes consist of a total of   sheets.

3. This report contains indications relating to the following items:

   I   ☒ Basis of the opinion

   II   ☐ Priority

   III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

   IV   ☐ Lack of unity of invention

   V   ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

   VI   ☐ Certain documents cited

   VII ☐ Certain defects in the international application

   VIII ☐ Certain observations on the international application

Date of submission of the demand	Date of completion of this report
27.02.2004	07.06.2004

Name and mailing address of the international preliminary examining authority: European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Poppe, F Telephone No. +31 70 340-4378

I. Basis of the report

1. With regard to the **elements** of the international application *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)):*

Description, Pages

1-37   as originally filed

Claims, Numbers

1-48   as originally filed

Drawings, Sheets

1/5-5/5   as originally filed

2. With regard to the **language,** all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

   These elements were available or furnished to this Authority in the following language: , which is:

   ☐   the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).

   ☐   the language of publication of the international application (under Rule 48.3(b)).

   ☐   the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

   ☐   contained in the international application in written form.

   ☐   filed together with the international application in computer readable form.

   ☐   furnished subsequently to this Authority in written form.

   ☐   furnished subsequently to this Authority in computer readable form.

   ☐   The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

   ☐   The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

   ☐   the description,   pages:

   ☐   the claims,   Nos.:

   ☐   the drawings,   sheets:

5. ☐   This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	2-5,7-20,22-38,40-48
	No:	Claims	1,6,21,39
Inventive step (IS)	Yes:	Claims	
	No:	Claims	1-48
Industrial applicability (IA)	Yes:	Claims	1-48
	No:	Claims	

2. Citations and explanations

   see separate sheet

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

D1:   IETF Network Working Group, RAMSDELL B: "RFC 2633: S/MIME Version 3 Message Specification"
D2:   US-A-5958005

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of **claims 1, 6, 21 and 39** is not new in the sense of **Article 33(2) PCT**.

1.1. The document D1 is regarded as being the closest prior art to the subject-matter of claim 1, and discloses (the references in parentheses applying to this document):

a method of mimetic message settings selection on a messaging client, comprising the steps of:
- detecting an outgoing message (p. 9, l. 22);
- determining whether the outgoing message is related to a previously received message, the received message having messaging characteristics (p. 10, l. 28-40);
- determining messaging settings associated with the message characteristics of the received message where the outgoing message is related to a previously received message (p. 10, l. 28-40); and
- selecting the messaging settings associated with the message characteristics of the received message to control message characteristics of the outgoing message (p. 10, l. 28-40).

1.2. Following a corresponding reasoning leads to the conclusion that the subject-matter of the corresponding system claim 39 is also not novel.

1.3. Claims 6 and 21 do not add subject-matter to claim 1, and hence they are also not novel.

2. The present application does not meet the criteria of Article 33(1) PCT, because the

subject-matter of **claim 29** does not involve an inventive step in the sense of **Article 33(3) PCT**.

The method steps added by claim 29 to the method of claim 1 were already disclosed in D2 (referring in general to col. 10, l. 1-25):

• determining whether the received message comprises message restrictions established by a message sender where the outgoing message is related to a previously received message;

• determining whether processing of the outgoing message is allowed by the message restrictions where the received message comprises message restrictions; and

• processing the outgoing message in accordance with the selected messaging settings where processing of the outgoing message is allowed by the message restrictions;

solving the same problem as in this application of how to give a sender of a message control over what the recipient can do with the message once he received it (col. 2, l. 45-56).

The solution proposed in claim 29 can therefore not be considered as involving an inventive step.

3. Dependent claims 2-5, 7-20, 22-28, 30-38 and 40-48 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, the reasons being as follows.

3.1. The ways specified in claims 2-5 for solving the problem of how to determine that an outgoing message is related to a previously received message are well known to the skilled person.

3.2. Claims 7-12, 19 and 20 specify message design choices and the ensuing possibilities for perfecting the method of claim 1, which come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can readily be foreseen.

3.3. Claims 13-18 further detail the behaviour of the messaging client executing the method when it receives input from a user. The specified behaviour, e.g. alerting the user when its input changes any of the required message characteristics, is a behaviour the

skilled person could choose, without the exercise of inventive skill.

3.4. Claims 22-28 detail the behaviour of the messaging client when an outgoing message is related to multiple messages with conflicting messaging settings and/or characteristics. The problem and the proposed solution, e.g. (claim 27) selecting most secure settings among the conflicting settings are known from D1 (p. 11, l. 23-33).

3.5. Claims 30-32 detail the behaviour of the messaging client when a user attempts processing of an outgoing message that was forbidden by the message sender. The specified behaviour, involving e.g. contacting the message sender to request permission, is a behaviour the skilled person could choose, without the exercise of inventive skill.

3.6. The message characteristics mentioned in claims 33 and 48, and the signing and encryption techniques mentioned in claims 34 (S/MIME) and 35 (PGP) are well known to the person skilled-in-the-art.

3.7. Claim 38 specifies the behaviour when the outgoing message is not related to any received message. This behaviour, selecting default messaging settings, is the default behaviour present in any messaging client.

3.8. Claims 40-46 describe slight constructional changes to the system of claim 39 which come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can readily be foreseen.

3.9. Claims 36, 37 and 47 merely specify contexts in which the method of claim 1 and the system of claim 39 can be implemented.